

also include other distinguishing features of the combination), so that **the inventions recited in claims 2-31 are dependent (not independent) and the inventions of claims 1-31 are not distinct and a requirement for restriction must not be made. Thus, under 806 (C), Where inventions are related as disclosed but are not distinct as claimed, restriction is never proper.**

It is respectfully submitted that the basis for restriction practice is set forth in the following, wherein various portions thereof are highlighted for the Examiner's convenience:

802 Basis for Practice in Statute and Rules

802.02 Definition of Restriction

Restriction, a generic term, includes the practice of requiring an election between distinct inventions, for example, election between combination and subcombination inventions, and the practice relating to an election between independent inventions, for example, and election of species.

37 CFR 1.141 Different inventions in one national application.

(a) Two or more independent and distinct inventions may not be claimed in one national application, **except that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (§ 1.75) or otherwise include all the limitations of the generic claim.** (emphasis added)

See arguments below with respect to generic claim 1 and species claims 2-31 of the present claimed invention.

802.01 Meaning of "Independent" and "Distinct"

35 U.S.C. 121 quoted in the preceding section states that the Commissioner may require restriction if two or more **"independent and distinct"** inventions are claimed in one application. In **37 CFR 1.141**, the statement is made that **two or more "independent and distinct inventions" may not be claimed in one application.**

This raises the question of the subjects as between which the Commissioner may require restriction. This, in turn, depends on the **construction of the expression "independent and distinct" inventions.**

"Independent", of course, means not dependent. If "distinct" means the same thing, then its use in the statute and in the rule is redundant. If "distinct" means something different, then the question arises as to what the difference in meaning between these two words may be. The hearings before the committees of Congress considering the codification of the patent laws indicate that **35 U.S.C. 121**: "enacts as law existing practice with respect to division, at the same time introducing a number of changes."

The report on the hearings does not mention as a change that is introduced, the subjects between which the Commissioner may properly require division.

The term **"independent"** **as already pointed out, means not dependent.** A large number of subjects between which, prior to the 1952 Act, division had been proper, are dependent subjects, such as, for example, combination and a subcombination thereof; as **process and apparatus** used in the practice of the process; as **composition and the process** in which the composition is used; as **process and the product** made by such process, etc. If section 121 of the 1952 Act were intended to direct the Commissioner never to approve division between dependent inventions, the word "independent" would clearly have been used alone. If the Commissioner has authority or discretion to restrict independent inventions only, then restriction would be improper as between dependent inventions, e.g., the examples used for purpose of illustration above. Such was clearly not the intent of Congress. Nothing in the language of the statute and nothing in the hearings of the committees indicate any intent to change the substantive law on this subject. On the contrary, joinder of the term "distinct" with the term "independent", indicates lack of such intent. The law has long been established that dependent inventions (frequently termed related inventions) such as used for illustration above **may be properly divided if they are, in fact, "distinct" inventions**, even though dependent. (emphasis added)

INDEPENDENT

The term **"independent"** (i.e., not dependent) means that there is no **disclosed relationship between the two or more subjects disclosed**, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process. (emphasis added)

DISTINCT

The term **"distinct"** means that two or more subjects as disclosed are **related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER** (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term related is used as an alternative for dependent in referring to subjects other than independent subjects.

It is further noted that the terms "independent" and "distinct" are used in decisions with varying meanings. All decisions should be read carefully to determine the meaning intended. (emphasis added)

803 Restriction - When Proper

Under the statute **an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - § 806.05(i)).**

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. (emphasis added)

CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

There are **two criteria for a proper requirement for restriction between patentably distinct inventions:**

- (A) **The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and**
- (B) **There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).** (emphasis added)

806 Determination of Distinctness or Independence of Claimed Inventions

The **general principles relating to distinctness or independence** may be summarized as follows:

- (A) **Where inventions are independent (i.e., no disclosed relation therebetween), restriction to one thereof is ordinarily proper, MPEP § 806.04 - § 806.04(i), though a reasonable number of species may be claimed when there is an allowed (novel and unobvious) claim generic thereto. 37 CFR 1.141, MPEP § 809.02 - § 809.02(e).**
- (B) **Where inventions are related as disclosed but are distinct as claimed, restriction may be proper.**
- (C) **Where inventions are related as disclosed but are not distinct as claimed, restriction is never proper.**

Where restriction is required by the Office double patenting cannot be held, and thus, it is imperative the requirement should never be made where related inventions as claimed are not distinct. For (B) and (C) see **MPEP § 806.05 - § 806.05(i)** and **§ 809.03**. See **MPEP § 802.01** for criteria for patentably distinct inventions. (emphasis added)

806.01 Compare Claimed Subject Matter

In passing upon questions of double patenting and restriction, it is the claimed subject matter that is considered and such **claimed subject matter must be compared in order to determine the question of distinctness or independence.** (emphasis added)

806.02 Patentability Over the Prior Art Not Considered

For the purpose of a decision on the question of restriction, and for this purpose only, the claims are ordinarily assumed to be in proper form and patentable (novel and unobvious) over the prior art.

This assumption, of course, is not continued after the question of restriction is settled and the question of patentability of the several claims in view of prior art is taken up.

806.04 Independent Inventions

If it can be shown that the two or more inventions are in fact independent, applicant should be required to restrict the claims presented to but one of such independent inventions. For example:

(A) Two different combinations, not disclosed as capable of use together, having different modes of operation, different functions or different effects are independent. An article of apparel such as a shoe, and a locomotive bearing would be an example. A process of painting a house and a process of boring a well would be a second example.

(B) Where the two inventions are **process and apparatus**, and the apparatus cannot be used to practice the process or any part thereof, they are independent. A specific process of molding is independent from a molding apparatus which cannot be used to practice the specific process.

(C) Where species under a genus are independent, for example, a genus of paper clips having species differing in the manner in which a section of the wire is formed in order to achieve a greater increase in its holding power.

SPECIES ARE TREATED EXTENSIVELY IN THE FOLLOWING SECTIONS.

(emphasis added)

806.04(a) Species - Genus

35 U.S.C. 121 provides that restriction may be required to one of two or more independent and distinct inventions. However, **37 CFR 1.141** provides that a reasonable number of species may still be claimed in one application if the other conditions of the rule are met.

806.04(b) Species May Be Related Inventions

Species, while usually independent, may be related under the particular disclosure. Where inventions as disclosed and claimed are both (A) species under a claimed genus and (B) related, then the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to other types of restrictions such as those covered in **MPEP § 806.05 - § 806.05(i)**. **If restriction is improper under either practice, it should not be required.**

For example, **two different subcombinations usable with each other may each be a species of some common generic invention.** In *Ex parte Healy*, 1898 C.D. 157, 84 O.G. 1281 (Comm'r Pat. 1898), a clamp for a handle bar stem and a specifically different clamp for a seat post both usable together on a bicycle were claimed. In his decision, the Commissioner considered both the restriction practice under election of species and the practice applicable to restriction between combination and subcombinations.

(emphasis added)

806.04(d) Definition of a Generic Claim

In an application presenting three species illustrated, for example, in Figures 1, 2, and 3, respectively, a generic claim should read on each of these views; but the fact that a claim does so read is not conclusive that it is generic. It may define only an element or subcombination common to the several species.

It is not possible to define a generic claim with that precision existing in the case of a geometrical term. In general, a generic claim should include no material element additional to those recited in the species claims, and must comprehend within its confines the organization covered in each of the species.

For the purpose of obtaining claims to more than one species in the same case, the generic claim cannot include limitations not present in each of the added species claims. Otherwise stated, **the claims to the species which can be included in a case in addition to a single species must contain all the limitations of the generic claim.**

Once a claim that is determined to be generic is allowed, all of the claims drawn to species in addition to the elected species which include all the limitations of the generic claim will ordinarily be obviously allowable in view of the allowance of the generic claim, since the additional species will depend thereon or otherwise include all of the limitations thereof. When all or some of the claims directed to one of the species in addition to the elected species do not include all the limitations of the generic claim, then that species cannot be claimed in the same case with the other species. See **MPEP § 809.02(c)**. (emphasis added)

806.04(e) Claims Restricted to Species

Claims are definitions of inventions. *Claims are never species*. Claims may be restricted to a single disclosed embodiment (i.e., a single species, and thus be designated a *specific species claim*), or a claim may include two or more of the disclosed embodiments within the breadth and scope of definition (and thus be designated a *generic or genus claim*).

Species are always the specifically different embodiments.

Species are *usually* but not always independent as disclosed (see **MPEP § 806.04(b)**) since there is usually no disclosure of relationship therebetween. The fact that a genus for two different embodiments is capable of being conceived and defined, does not affect the independence of the embodiments, where the case under consideration contains no disclosure of any commonality of operation, function or effect.

806.04(f) Claims Restricted to Species, by Mutually Exclusive Characteristics

Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species.

806.04(h) Species Must Be Patentably Distinct From Each Other

Where an applicant files a divisional application claiming a species previously claimed but nonelected in the parent case, pursuant to and consonant with a requirement to restrict, there should be no determination of whether or not the species claimed in the divisional application is patentable over the species retained in the parent case since such a determination was made before the requirement to restrict was made.

In a national application containing claims directed to more than a reasonable number of species, the examiner should not require restriction to a reasonable number of species unless he or she is satisfied that he or she would be prepared to allow claims to each of the claimed species over the parent case, if presented in a divisional application filed according to the requirement. Restriction should not be required if the species claimed are considered clearly unpatentable over each other.

In making a requirement for restriction in an application claiming plural species, the examiner should group together species considered clearly unpatentable over each other, with the statement that restriction as between those species is not required.

Where generic claims are allowed in a national application, applicant may claim in the *same application* additional species as provided by **37 CFR 1.141**.

Where, however, an applicant optionally files another national application with claims to a different species, or for a species disclosed but not claimed in a parent case as filed and first acted upon by the examiner, there should be close investigation to determine the presence or absence of patentable difference. See **MPEP § 804.01** and **§ 804.02**.

806.05 Related Inventions

Where two or more related inventions are being claimed, the principal question to be determined in connection with a requirement to restrict or a rejection on the ground of double patenting is whether or not the inventions as claimed are distinct. If they are distinct, restriction may be proper. **If they are not distinct, restriction is never proper.** If nondistinct inventions are claimed in separate applications or patents, double patenting must be held, except where the additional applications were filed consonant with a requirement to restrict in a national application.

The various pairs of related inventions are noted in the following sections.
(emphasis added)

806.05(c) Criteria of Distinctness for Combination, Subcombination, or Element of a Combination

In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated.

To support a requirement for restriction, both **two-way distinctness and reasons for insisting on restriction are necessary**, i.e., separate classification, status, or field of search. See **MPEP § 808.02**.

The inventions are distinct if it can be shown that a combination as claimed:

(A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and

(B) the subcombination can be shown to have utility either by itself or in other and different relations.

When these factors cannot be shown, such inventions are not distinct.

The following examples are included for general guidance. (emphasis added)

II. SUBCOMBINATION ESSENTIAL TO COMBINATION

ABsp/Bsp

No Restriction

If there is no evidence that combination ABsp is patentable without the details of Bsp, restriction should not be required. **Where the relationship between the claims is such that the separately claimed subcombination Bsp constitutes the essential distinguishing feature of the combination ABsp as claimed, the inventions are not distinct and a requirement for restriction must not be made, even though the subcombination has separate utility.** (emphasis added)

It is respectfully submitted that in the present application, claim 1 includes the essential distinguishing feature of the combination as claimed (although claims 2-31 may also include other distinguishing features of the combination), so **the inventions recited in claims 2-31 are dependent (not independent)** the inventions of **claims 1-31 are not distinct and a requirement for restriction must not be made.**

37 C.F.C. 1.141 states that **more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (§ 1.75) or otherwise include all the limitations of the generic claim.**

In patent prosecution, the ordinary meanings of claim terms are generally utilized. For example, in *The Dow Chemical Company v. Sumitomo Chemical Company, Ltd. and Sumitomo Chemical American, Inc.*, 59 USPQ2d p. 1614 (CAFC July 25, 2001), the court stated: "We look first to the claim language itself, to define the scope of the patented invention." *Vitrionics Corp v. Conceptronic, Inc.*, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996). It is respectfully submitted that, generally, **the ordinary meaning of terms is utilized in interpreting the meaning of the rules**

that set forth the basis for restriction in patent applications. A generic claim is a claim to a generic invention, usually including within its scope the subject matter of subordinate (narrower) claims (in the present instance, claim 1 is a generic claim and is included in dependent claims 2-31) because claims 2-31 depend from claim 1, and a species claim is a claim within the scope of, but not coextensive with, another claim in the same application or patent (in the present instance, claims 2-31 are species claims).

Hence, it is respectfully submitted that claim 1 of the present claimed invention is an independent claim which is a generic claim setting forth a light resistant colorant obtained by coupling a colorant with a light resistant material represented by Formula 1 (see application), and claims 2-31 are dependent claims depending, directly or indirectly, from claim 1, and which are species claims that are within the scope of, but not coextensive with, claim 1, and which include all the limitations of the generic claim, claim 1, because they each depend therefrom and provide further limitation thereto. Thus, it is respectfully submitted that **claims 1-31 may be claimed in one application in accordance with Example II of MPEP 806.05(c).** Thus, **claims 1-31 are submitted to be properly represented as Group IA.**

Thus, Applicants alternatively provisionally elect **Group IA (claims 1-31)** in response to the preliminary restriction requirement set forth in the Office Action.

II. Applicants Traverse the Requirement

Insofar as Groups 1-20 are concerned, it is believed that claims 1-31 are very closely related, represent a generic claim having a plurality of species claims as described above, so that, as indicated by **Example II of MPEP 806.05(c)**, claims 1-31 should remain in the same application. The elected claims 1-31 represent a product and a plurality of limitations thereto, and are not different types of claims such as a method and an apparatus or a process and a product. There have been no references cited to show any necessity for requiring restriction and, in fact, it is believed that the Examiner would find references containing the 1-31 claims in the same field of technology. While it is noted that the Examiner has identified different classifications, primarily based on subgroups, for the product (see Groups I-XX) it is believed that the classification suggested by the Examiner is not conclusive on the question of restriction. It is believed, moreover, that evaluation of the sets of claims I through XX would not provide an undue burden upon the Examiner at this time in comparison with the additional expense and delay to Applicants in having to protect the additional subject matter recited by the Groups I through XX claims by filing divisional applications.